

App. No. 09/446,839
Amdt. Dated January 13, 2004
Reply to Office Action of October 20, 2003

REMARKS/ARGUMENTS

Claims 14 – 25 are pending in the application.

An interview was conducted between the Examiner and Applicants' representative on November 4, 2003. The substance of this interview is correctly summarized in the Examiner's 11/07/2003 Interview Summary, namely that a proposed change to claim 14 was discussed, whereby the word "stone" would be changed to read "gemstone". Applicants submitted that the Reber reference, which uses silicon, is not a stone, and at least could not be considered to be a gemstone. The Examiner indicated that further consideration would be required to determine if Reber would still anticipate claim 14 if the latter were amended to read "gemstone". Furthermore, the Examiner presented an argument based on case law concerning the selection of known materials. No agreement regarding claim 14 was reached.

In conformity with the aforementioned interview, and the Examiner's comments in the subject Office Action, claim 14 has been amended to indicate that the body of the ornamental stone comprises a natural or synthetic gemstone.

Page 1 of the specification of the instant application indicates that artificially manufactured diamond layers that are produced through a CVD process are either too expensive or too thin to produce cut gemstones therefrom. Therefore, the object of the present application is how to impart suitability for jewelry to those natural and artificial gemstones that can be used only for technical or industrial purposes.

The Examiner has rejected, among others, claim 14 as being anticipated by Reber '329. This reference discloses a "body" in the form of a semiconductor substrate,

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i.e. a substrate made of semiconductor material (not a gemstone, nor any suggestion of a gemstone). Furthermore, Reber '329, in column 1, line 61, states that the semiconductor material can be "reject quality material". In other words, this semiconductor material of Reber is not "suitable only for technical or industrial purposes", as specifically required by Applicants' claim 14. It is respectfully submitted that this requirement is not merely an intended use, but rather is a specific limitation regarding a characteristic of the gemstone that comprises the body of Applicants' ornamental stone. Applicants would furthermore like to point out that Reber is intended only for decorative materials, such as jewelry (see e.g. column 1, lines 12 - 16, claim 1, and the abstract). In contrast, with the present application gemstones of low quality (i.e. "reject quality material" as in Reber) cannot, by definition in Applicants' claim 14, be used since of course then they are not "suitable only for technical or industrial purposes".

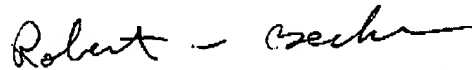
In view of the foregoing discussion, it is respectfully submitted that at least with regard to two features that are required by Applicants' claim 14, Reber does not teach every element of Applicants' claim 14, and therefore, as indicated in MPEP Section 2131, last paragraph, Reber cannot anticipate this claim. Furthermore, Reber cannot suggest the features of claim 14, since it clearly teaches away from the requirement not only that the body be a gemstone, but also that such gemstone be suitable only for technical or industrial purposes. Therefore, pursuant to MPEP Section 2141.02, last paragraph, Reber also is not a proper reference since this paragraph of the MPEP requires that "a prior art reference must be considered in its entirety, i.e., as a whole,"

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including portions that would lead away from the claimed invention".

In view of the foregoing discussion, Applicants respectfully request reconsideration of the allowability of claim 14, as amended. In addition, should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call from him to discuss any outstanding issues, and in particular any further amendments to the claims to bring the application into condition for allowance.

Respectfully Submitted,



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